

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAVOR KOLEV, DAVID GREGORY,
GREGORY DUNKO and MARK RANTA

Appeal No. 2003-0705
Application No. 09/144,024

ON BRIEF

Before KRASS, GROSS and BLANKENSHIP, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1, 3-5, 7-13, 17-19, 23, 25, 27, 29-31, 34 and 36-43.

The invention is directed to a system for indicating the type of call that is being sent from a first radio-communication device to a second radio-communication device, especially where the second device is in a disadvantaged mode of operation relative to the first device. A “disadvantaged” mode of operation occurs where the second device

can receive only the high power signals, and cannot communicate with the first device along a return low-power channel.

Representative independent claim 23 is reproduced as follows:

23. A method for communicating a call-type in a satellite radio-communication system wherein a mobile radio-communication device is operating in a disadvantaged mode, the method comprising:

transmitting a paging message including a designation of the call-type;

wherein the paging message further comprises a first string designating a request for a communication corresponding to the call-type and the communication is to take place when the mobile radio-communication device is operating in an advantaged mode in which two-way communication is possible.

The examiner relies on the following references:

Thompson	5,465,401	Nov. 7, 1995
Foladare et al. (Foladare)	5,894,595	Apr. 13, 1999 (filed Feb. 21, 1997)
Helferich	6,087,956	Jul. 11, 2000 (filed Sep. 19, 1997)

Claims 1, 3-5, 7-13, 17-19, 23, 25, 27, 29-31, 34 and 36-43 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner offers Helferich and Thompson with regard to claims 1, 3-5, 7-13, 17-19, 23, 25, 27, 29-31 and 34. The examiner offers Foladare and Helferich with regard to claims 36-43.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the

evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1040, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR 1.192 (a)].

With regard to the first rejection, involving Helferich and Thompson, the examiner asserts that Helferich discloses the claimed limitations but for a satellite communication system. The examiner then relies on Thompson for the teaching of a mobile radio-communication device that communicates RF signals either from land lines or satellite networks, finding that it would have been obvious to provide Thompson's teaching to Helferich.

With regard to the second rejection, involving Foladare and Helferich, the examiner finds that Foladare discloses the claimed subject matter but for the "disadvantage" mode. The examiner relies on Helferich's disclosure of such a mode when the device is in a subway or basement, finding that when a device is not working because of an obstructed area, it is "inherently" operating in a "disadvantaged" mode. The examiner finds that both the "advantage" and "disadvantage" mode "inherently" occur depending on the location of the mobile device.

Appellants argue that the examiner has provided an insufficient motivation for combining the references and that the references do not disclose the “advantage” and “disadvantage” modes, as claimed, and as defined in the instant specification.

First, with regard to the question of motivation to combine, the examiner clearly has provided a motivation to combine, at page 8 of the answer, wherein the examiner explains that Thompson uses a satellite communication network and that it is well known that satellite communication networks are utilized to provide a communication link in rural areas where land line communication links are not available or possible. The examiner explains, further, that since both references deal with wireless communications networks, it would have been obvious to apply Thompson’s satellite communications network to Helferich’s system so that a mobile device can be reached in rural areas where land line communication links are not available.

The examiner presents a reasonable case for leading skilled artisans to combine the references. Yet, appellants do not respond to this explanation. Accordingly, we find sufficient motivation to combine the references.

At pages 3-4 of the specification, appellants state that the “advantaged” mode of operations “occurs where the second radio-communication device can receive both low and high power signals from the first radio-communication device, and can communicate with the first radio-communication device along a return low-power channel.” The “disadvantaged” mode of operations “occurs where the second radio-

communication device can receive only the high power signals, and cannot communicate with the first radio-communication device along a return low-power channel.”

Each of the instant claims on appeal contains a recitation of each of these modes of operations. The meaning of these terms must be ascertained from reference to the specification. When reference to the specification is made, a very specific definition is provided for each of these terms.

The examiner attempts to equate Helferich’s disclosure of notifying a user of a pager that a message is received and that the user can decide to review the entire message at a later time, to a “disadvantaged” mode. The examiner also alleges that “any two-way mobile device **inherently** operates in an advantage mode (two-way mode) in a normal condition, and **inherently** operates in a disadvantage mode when the device is located in an obstructed area” (answer-page 8). It is the examiner’s view that a device is in a “disadvantaged” mode when a user is in a subway, basement, or an airplane, or anywhere where a location prevents a signal from reaching the device, or, “where the mobile device can not response (sic, respond) to a base station or a satellite because of low power transmission of the mobile device and because of signal obstructions” (answer-page 9).

We have a definition of the terms “disadvantaged” and “advantaged” and that definition is set forth by appellants within the specification. Thus, we, and the examiner,

are bound by those definitions. While the references need not employ the same terms, in haec verba, there must be some teaching or suggestion of a mode of operations where the second radio-communication device can receive both low and high power signals from the first radio-communication device, and can communicate with the first radio-communication device along a return low-power channel, and there must be some teaching or suggestion of a mode of operations where the second radio-communication device can receive only the high power signals, and cannot communicate with the first radio-communication device along a return low-power channel.

It is our view that the examiner has reasonably identified these defined “disadvantaged” and “advantaged” modes of operation in Helferich in identifying that when there is good, two-way communication between the devices, that is the “advantaged” mode, and when there is some obstruction, so that there is only one-way communication (i.e., the second device cannot respond to the first), this is the “disadvantaged” mode.

Appellants contend that the disadvantaged and advantaged modes relate to whether or not two-way communication is even possible (principal brief-page 7) and that the disadvantaged mode is one wherein only a one-way communication link is possible, the advantaged mode being one wherein two-way communication is possible. With appellants’ own definitions in mind, clearly, when both devices are operating and communicating with each other, there is two-way communication and this equates to an

“advantaged” mode, as defined, and argued, by appellants. When there is an obstruction in Helferich and the second device cannot respond, there is, arguably, only one-way communication, meeting appellants’ argued definition. Accordingly, we agree with the examiner that Helferich suggests, though it does not recite the exact terms of, “advantaged” and “disadvantaged” modes of operation.

Appellants’ argument, at page 7 of the principal brief, that Helferich is related primarily to saving battery power and memory space, is irrelevant if, as we find, the reference discloses (together with Thompson) the subject matter, as claimed. Contrary to appellants’ position, the definitions of “advantaged” and “disadvantaged” modes of operation do not run contrary to the teaching of Helferich. Moreover, the instant claims do not preclude saving battery power and memory space.

Appellants argue, further, that the claims go beyond simply citing and defining two modes, in that they also recite that the call type indication is sent and received when the mobile unit is in the disadvantaged mode, but the call in question is to take place while the mobile unit is operating in the advantaged mode.

Helferich clearly discloses such a call type indication. At column 2, Helferich explains that there are times when a paging transceiver cannot issue a reply to a base station that has sent a message (this is appellants’ “disadvantaged” mode since there is only one-way communication). Helferich also suggests, throughout column 3, that the page transceiver may give the user an indication that a message has been received, as well as the type of message (column 3, lines 18-20) and the user can then decide

when/whether to retrieve the message. When the user retrieves the message and, possibly answers it (the user does have a transceiver, which is capable of transmitting and receiving), this results in two-way communication (“advantaged” mode).

Accordingly, appellants’ argument in this regard is not persuasive.

With regard to claims 3, 4 and 5, describing facsimile, data and voice communication indications, such specific types of communication are clearly suggested by Helferich’s disclosure of the type of message being “e-mail, voice, or text” (column 3, line 19) and the paging transceiver not being limited to voice messages, but, rather, it may include “numeric messages, alphanumeric messages, voice or other audio messages, video messages, graphics or even data” (column 15, lines 43-48).

With regard to claims 10 and 27, appellants’ argument focuses on neither of the applied references disclosing or suggesting the existence of a “disadvantaged mode” (principal brief-page 8) and that because they do not disclose or suggest this mode, they cannot disclose or suggest the selective reception of a paging message using an ID code in a disadvantaged mode.

The argument is not persuasive because, for the reasons supra, we do find that Helferich suggests a “disadvantaged mode.”

With regard to claims 11, 12, 17, 18, 25 and 29, appellants state that these claims relate to the specific 53 bit message sent to mobile terminals to communicate the ID code for the terminal, and the call type indication in disadvantaged mode, while

claims 13 and 30 add limitations related to the Asis Cellular Satellite standard and claim 31 adds a qualifier that the call type indication is at least 3 bits in length.

Appellants do not present any substantive argument regarding these limitations, preferring, instead, to merely recite the claim limitations and argue that they are not “design choice,” as alleged by the examiner. Since the examiner has indicated, reasonably, that the artisan would have found the number of bits and the particular standard to have been obvious design choices and appellants have offered nothing to counteract this allegation, as in showing some criticality to the use of only these bit numbers and standard, we will sustain the rejection of these claims under 35 U.S.C. §103.

With regard to claims 36-43, appellants, again, argue motivation to combine and no suggestion of the advantaged and disadvantaged modes. Since we have already discussed Helferich’s advantaged and disadvantaged modes, supra, we do not find these arguments persuasive. With regard to the combinability, we are satisfied with the examiner’s explanation, at page 11 of the answer, as to why the artisan would have combined the references (“both disclose a message type or call type is included as part of a paging signal...).

The specifics of claims 37-42, discussed by appellants at pages 9-10 of the principal brief, have been treated supra with regard to similar claims and the rejections of these claims under 35 U.S.C. §103 is sustained for the same reasons.

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The decision of the examiner rejecting claims 1, 3-5, 7-13, 17-19, 23, 25, 27, 29-31, 34 and 36-43 under 35 U.S.C. §103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ANITA PELLMAN GROSS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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HOWARD B. BLANKENSHIP)	
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